

Application No.: 09/368817

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**REMARKS**

Claims 1-6, 20-23, 26-35, and 40-43 are pending. Applicants appreciate the allowance of claims 20-23 and 40-43.

**I. § 102 Rejections**

Claims 1-6, 26-30, 32-35 stand rejected under 35 USC § 102(e) as being anticipated by Gelbman. (U.S. Pat. No. 6,753,830).

MPEP §2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claims.

The Office Action stated that Gelbman teaches an electronic, radio frequency label 16 (col. 2, lines 10+; col. 4, line 26+) comprising a display means 14 which displays either machine – readable or human-readable information. The label obviously displays information relevant to the items on which the label is attached. The displayable item-related information includes item-specific information including location (col. 5, lines 60+). Some item-related information such as lot number of manufacturer can certainly be used as a criterion for classifying items. Applicants respectfully disagree for at least the following reasons.

**A. Claim 1**

First, Gelbman does not disclose that the electronic label 16 includes an interrogation source. (It appears from the text of the Office Action reproduced above that the Examiner is asserting that the electronic label 16 itself is considered the "RFID device.") The electronic label 16 does not interrogate another label. In fact, Gelbman teaches that the electronic label 16 does not include an onboard power source (See column 2, lines 10-14), and therefore, it could not function as an interrogator because it lacks the power source to interrogate other labels.

Second, Gelbman does not disclose an RFID device that comprises an indicator for indicating information regarding a class of materials to which the item belongs. The Examiner

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asserts that a lot number or manufacturer can be used as a criterion for classifying items. However, the mere suggestion that the storage element 28 in the electronic label 16 could include a lot number or manufacturer does not automatically mean that the label indicates information regarding the class of materials to which the item belongs, nor does Gelbman suggest any intention to classify items into such classes. Gelbman only discloses displaying information on the label that has either been sent to the label, stored in the label or some combination of sent and stored information. There is no disclosure or suggestion to take such information and to classify items into classes based on such information. In fact, Gelbman includes a long list of information that may be stored in the storage element of the electronic label (see column 5, line 60 through column 6, line 6), but there is no reference whatsoever to the "class of materials."

Third, Gelbman does not disclose an RFID device that comprises an indicator for indicating information regarding a desired location for that item. Gelbman includes a long list of information that may be stored in the storage element of the electronic label (see column 5, line 60 through column 6, line 6), but Gelbman makes no mention whatsoever of the *desired location* of the item. The only mention of "location" in Gelbman's list of information that may be stored in the electronic label is "retail store name and location," which does provide the desired location of the item to which the label is attached.

In contrast, claim 1 recites an RFID device that comprises "(b) an indicator for indicating information regarding one or both of (i) a class of materials to which the item belongs, and (ii) a desired location for that item. An example of such an RFID device is taught in the specification, for instance on page 21, lines 7-18, which states as follows:

Each library designates their own sorting categories including, for example, adult non-fiction, children's fiction, materials that are being held, and materials that were or will be on ILL (inter-library loan) to another library branch. When an operator begins the sorting operation, he or she can use the RFID device to scan the RFID element associated with a material, and receive, for example, a visual or audible signal of the category to which the material belongs, and the cart or container holding materials within that category, as shown in Figure 9. For example, the operator may scan a book, learn that it is in the children's fiction category, and learn that it belongs on cart number 123. The identification of the material, category, and temporary (initial) or permanent (final) location of the item may occur in response to information obtained from the RFID element, from LAV software, from a separate sorting database, from another source, or from a combination of the foregoing.

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Therefore, contrary to the Office Action's assertion that all elements of claim 1 are disclosed in Gelbman, elements (a) and (b) of claim 1 are not; the rejection is unsupported by the art and should be withdrawn. Applicants therefore requests the rejection of claim 1 under 35 USC § 102(e) over Gelbman et al. be withdrawn. Claims 2-6, which depend from claim 1 and add further limitations, are likewise patentable over Gelbman and the rejection should be withdrawn. Applicants therefore requests the rejection of claims 1-6 under 35 USC § 102(e) over Gelbman withdrawn.

**B. Claim 26**

First, Gelbman does not disclose an RFID device for identifying and locating items having an RFID element associated therewith in the sections of Gelbman referenced in the Office Action. (It appears from the text of the Office Action reproduced above that the Examiner is asserting that the electronic label 16 itself is considered the "RFID device.") The electronic label 16 does not identify and then locate items that the label is attached to.

Second, Gelbman does not disclose that the electronic label 16 includes the capability to interrogate items to determine the identity of the items. The electronic label 16 does not interrogate another label. In fact, as mentioned above, Gelbman teaches that the electronic label 16 does not include an onboard power source (See column 2, lines 10-14), and therefore, it could not interrogate other items because it lacks the power source to interrogate other labels.

Third, Gelbman does not disclose that the electronic label 16 includes the capability to associating items with a particular location. The electronic label 16 does not interrogate another label. In fact, as mentioned above, Gelbman teaches that the electronic label 16 does not include an onboard power source (See column 2, lines 10-14), and therefore, it could not associate items with a particular location because it lacks the power source to do so.

Therefore, contrary to the Office Action's assertion that all elements of claim 26 are disclosed in Gelbman, at least elements (b) and (c) of claim 26 are not; the rejection is unsupported by the art and should be withdrawn. Applicants therefore requests the rejection of claim 26 under 35 USC § 102(e) over Gelbman et al. be withdrawn. Claims 27-30 and 32-35, which depend from claim 26 and add further limitations, are likewise patentable over Gelbman

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and the rejection should be withdrawn. Applicants therefore requests the rejection of claims 26-35 under 35 USC § 102(e) over Gelbman withdrawn.

In conclusion, the rejection of claims 1-6, 26-30, and 32- 35 under 35 USC § 102(e) as being anticipated by Gelbman has been overcome and should be withdrawn.


Withdrawal of the outstanding rejections and allowance of the pending claims is respectfully requested. If a telephonic conference would be helpful in resolving any outstanding matters in the present application, the Examiner is encouraged to contact Applicants' undersigned representative.

Respectfully submitted,

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